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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/687,412	10/12/2000	Howard J. Glaser	STL920000092US1	1235
24852	7590	11/09/2004	EXAMINER	
INTERNATIONAL BUSINESS MACHINES CORP			NGUYEN BA, HOANG VU A	
IP LAW			ART UNIT	PAPER NUMBER
555 BAILEY AVENUE, J46/G4			2122	
SAN JOSE, CA 95141				

DATE MAILED: 11/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	09/687,412	GLASER ET AL.	
	Examiner	Art Unit	
	Hoang-Vu A Nguyen-Ba	2122	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 22 July 2004.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-15 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-15 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____.

DETAILED ACTION

1. This action is responsive to the amendment filed July 22, 2004.
2. Claims 1-15 are pending.

Response to Amendment

3. Per Applicants' request, claims 1, 2, 3, 5, 6, 7, 8, 10, 11, 12, 13 and 15 have been amended.

Response to Arguments

4. Applicants' arguments with respect to claims 1-11, which have been rejected under 35 U.S.C. § 112, first paragraph, have been considered and are persuasive. The rejection of these claims under 35 U.S.C. § 112, first paragraph are thus withdrawn.
5. Applicants' arguments with respect to claims 1-11, which have been rejected under 35 U.S.C. § 112, second paragraph, have been considered and are not persuasive. The rejection of these claims under 35 U.S.C. § 112, second paragraph is maintained.
6. Applicant's arguments with respect to claims 1-15, which have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Kenner in view of Stedman have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-15 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 6 and 11 recite the limitations “determining if the item described in the user configuration has been updated with an updated item” and “retrieving the updated item if the item has been updated.” The use of the modifier “updated” twice in these limitations is confusing because it is not clear why there is a need to determine the status of an updated item and to retrieve this updated item if this item has already been updated. Correction is required. For art rejection purposes, the above limitations are interpreted to mean – determining if the item described in the user configuration has been updated – and – retrieve the updated item if the item is not up-to-date. –

Claims 1, 6, and 11 recite the limitation “the application program may be built.” The recitation of the limitation is in permissive language. The broadest reasonable interpretation of this limitation is that this feature of “may be built” is optional feature. The use of the verb “may be” renders the claim indefinite. Accordingly, any arguments that this feature provides patentable distinction over the prior art are unpersuasive.

Claims 2-5, 7-10 and 12-15, which depend respectively from claims 1, 6 and 11 are also rejected under 35 U.S.C. § 112, second paragraph, for containing the same confusing and indefinite language of claims 1, 6 and 11.

9. Claim 11 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A single claim, which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph. In *Ex parte Lyell*, 17 USPQ 2d 1548 (Bd. Pat. App. & Inter. 1990), a claim directed to an automatic transmission workstand and the method steps of using it was held to be ambiguous and properly rejected under 35 U.S.C. 112, second paragraph.

In claim 11, it is unclear whether a computer system or a method for updating an application program is claimed. With a computer system recited in the preamble, one would expect to find in the body of the claim components having functions to update an application program. However, one found a mixture of software components (e.g., user configuration of the application program, application builder for building the application program) and method steps for updating an application program (e.g., determination, download, determination, retrieval).

Correction is required.

Claim Rejections – 35 USC § 101

10. 35 U.S.C. § 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

11. Claims 11-15 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Pursuant to claim 11, a single claim which claims both an apparatus and the method steps of using the apparatus should also be rejected under 35 U.S.C. 101, *Ex parte Lyell*, 17 USPQ 2d 1548 (Bd. Pat. App. & Inter. 1990), based on the theory that the claim is directed to neither a “process” nor a “apparatus,” but rather embraces or overlaps two different statutory classes of invention set forth in 35

U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only. *Id.* at 1551.

Claims 12-15, which depend from claim 11 is also rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Correction is required.

Claim Rejections – 35 USC § 103

12. The following is a quotation of the 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1, 6 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,205,476 to Hayes, Jr. (“Hayes”) in view of U.S. Patent No. 6,314,565 to Kenner.

Claims 1, 6 and 11

Hayes discloses at least:

defining a user configuration of the application program corresponding to the particular user of the application program at the remote data processing system, the user configuration describing an item from which the application program may be built (see at least column 22);

determining that the user configuration corresponds to the particular user (see at least column 12);

downloading the user configuration to the local data processing system in response to determining that the user configuration corresponds to the particular user (see at least column 12)

Hayes does not specifically disclose the remaining method steps of claims 1, 6 and 11. However, Kenner discloses these remaining steps as follows:

determining if the item described in the user configuration has been updated (see at least Figure 2, step 220 and related discussion in the specification);

retrieving the updated item if the item has been up-to-date (see at least Figure 2, step 230 and related discussion in the specification); and

building the application program with the updated item (see at least 8:30-41).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to add these steps taught by Kenner to those taught by Hayes to improve the remote and customized updating and installing of computer programs.

14. Claims 2-5, 7-10 and 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,205,476 to Hayes, Jr. ("Hayes") in view of U.S. Patent No. 6,314,565 to Kenner, as applied respectively to base claims 1, 6 and 11, further in view of U.S. Patent No. 5,894,515 to Hsu and further in view of U.S. Patent No. 6,262,726 to Stedman et al. ("Stedman").

Claims 2, 7 and 12

Hayes further disclose *storing the user configuration in a manifest file, wherein the user configuration is downloaded to the local data processing system in the manifest file, and wherein determining that the user configuration corresponds to the particular user* (see at least column 22).

Hayes in view of Kenner does not specifically disclose *encrypting and decrypting*. However, Hsu teaches encrypting data (see at least 1:13-21). It would have been

obvious to a person having ordinary skill in the art at the time the invention was made to add Hsu's encrypting feature to Hayes-Kenner combined teaching, as this feature would provide protection for Hayes' configuration files.

The combined teaching Hayes-Kenner-Hsu does not specifically disclose *authenticating the particular user in response to the particular user requesting the application program*. However, Stedman teaches authenticating a particular user when the particular user attempts to initialize the operating system (see at least 6:55-58). It would have been obvious to a person having ordinary skill in the art at the time the invention was made to add Stedman' authenticating feature to the combined teaching Hayes-Kenner-Hsu, as this feature would provide additional protection for Hayes' configuration files.

Claims 3, 8 and 13

Hayes further discloses *storing the user configuration in a manifest file stored on the remote data processing system, wherein downloading the user configuration file to the local data processing system comprises downloading the manifest file from the remote data processing system to the local data processing system* (see at least column 22).

Hayes in view of Kenner does not specifically disclose *encrypting* and *decrypting*. However, Hsu teaches encrypting data (see at least 1:13-21). It would have been obvious to a person having ordinary skill in the art at the time the invention was made to add Hsu's encrypting feature to Hayes-Kenner combined teaching, as this feature would provide protection for Hayes' configuration files.

The combined teaching Hayes-Kenner-Hsu does not specifically disclose *authentication*. However, Stedman teaches authenticating a particular user when the particular user attempts to initialize the operating system (see at least 6:55-58). It would have been obvious to a person having ordinary skill in the art at the time the

invention was made to add Stedman' authentication feature to the combined teaching Hayes-Kenner-Hsu, as this feature would provide additional protection for Hayes' configuration files.

Claims 4, 9 and 14

The combined teaching Hayes-Kenner-Hsu further discloses *downloading data from the remote data processing system to the local data processing system according to the decrypted user configuration* (see at least column 22).

Claims 5, 10 and 15

Hayes further discloses *wherein the data is downloaded from the remote data processing system* (see at least column 22). Hayes in view of Kenner does not specifically disclose *authenticating the particular user in response to the particular user requesting the application program*. However, Hsu teaches encrypting data (see at least 1:13-21). It would have been obvious to a person having ordinary skill in the art at the time the invention was made to add Hsu's encrypting feature to Hayes-Kenner combined teaching, as this feature would provide protection for Hayes' configuration files.

Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoang-Vu "Antony" Nguyen-Ba whose telephone number is (571) 272-3701. The Examiner can normally be reached on Tuesday-Friday, 6:00 to 16:15.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Tuan Dam can be reached at (571) 272-3695. The fax phone

number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**ANTONY NGUYEN-BA
PRIMARY EXAMINER**

Art Unit 2122

November 3, 2004